

REMARKS

Applicant has carefully studied the Office Action of 06 November 2002 and offers the following remarks in response thereto. The remarks are supplemented, where appropriate, with comments from the telephonic interview of 27 January 2003.

Applicant is concurrently filing an Information Disclosure Statement electronically.

The present invention is directed to a network provider contracting with a customer to provide network connectivity having a certain characteristic. This characteristic may be a quality of service as defined by a number of packets lost, an amount of bandwidth, a guarantee of network availability at certain times, or the like. The network provider then attempts to provide the customer with the network service having that certain characteristic. The network provider further monitors the network service actually provided to the customer to see if the network provider is supplying the desired characteristic for which the customer has contracted. If the network provider has failed to provide the contracted characteristic, the network provider measures the network service actually provided and bills the customer for what was actually provided rather than what the customer originally wanted.

Applicant respectfully traverses the comment in the remarks section of the Office Action that the arguments made in the Appeal Brief are moot in light of the new grounds of rejection. In the Appeal Brief, Applicant argued that Egendorf, Hilt et al. and Melen et al. are non-analogous references and thus are unavailable to be cited against the present application as prior art. Applicant herein repeats these arguments. Specifically, for a reference to be analogous, the reference must be in the same field of endeavor or reasonably commend itself to an inventor faced with the problem solved by the invention. If the references are not within the field of available prior art because the references are non-analogous, then the rejection fails on its face and the claims are in a condition for allowance. Since the references are not concerned on face with determining a quality of service to a customer and billing the customer accordingly, the references are not within the same field of endeavor. Further, since nothing about the references commends them to be considered by someone interested in determining a quality of service to a customer and billing the customer accordingly, the references fail both parts of the test for analogousness. Since the references fail both parts of the test for analogousness, the references are non-analogous and the rejection fails. As all of the claims are rejected in part with at least Egendorf, claims 1-20 are allowable.

For the Patent Office to make a *prima facie* case of obviousness under 35 U.S.C. § 103, the Patent Office must show where in the combination of references each and every claim element is shown. MPEP § 2143.03. When making the rejection, the Patent Office is entitled to give claim terms their broadest reasonable interpretations. MPEP § 2111. This standard is limited by the term "reasonable" and by the fact that the interpretation is determined by one of ordinary skill in the art. MPEP § 2111.01

Claims 1-3 and 11-14 were rejected under 35 U.S.C. § 103 as being unpatentable over Egendorf in view of Gell and further in view of Rieken et al. In addition to the failure of Egendorf to be analogous art, this rejection is improperly constructed in that the combination does not show all of the claim elements that are alleged to be shown by the Patent Office. The Patent Office begins its analysis of claim 1 with the language that was addressed in the Appeal Brief. In fact, nothing has changed about this rejection except the addition of Gell and Rieken et al. and the analysis relating thereto. As explained in the Appeal Brief, Egendorf does not teach providing a computer network subscriber with a networking transmission service having a first characteristic, observing that the computer network subscriber is receiving networking transmission service with a second characteristic and billing based on the second characteristic rather than the first. As this has been addressed previously, it will not be further repeated here.

The Patent Office, in response to the Appeal Brief, supplemented Egendorf with Gell stating that Gell teaches "billing the subscriber for the secure, cost effective networking transmission service having the second characteristic with the vendor rather than the service having the first characteristic and teaches network security maintaining consequent quality of service for the customer," citing the Abstract, Figures 5A, 5B, 16, 1 and column 1, line 64-column 6, line 29. In fact, the reference teaches nothing relating to the claims. Gell is concerned with a user device having a selecting device that communicates with multiple service providers and selects a service provider based on pricing and other factors such as quality of service. This selection and pricing is prospective only to the extent that, as explained at column 5, lines 56-66 of the reference, it acts prospectively to select the service provider with the lowest price. There is no observing that the service actually provided has a different characteristic than that requested and there is no billing the customer according to the characteristic actually provided rather than that requested. The closest the reference comes to this sort of feedback is at column 8, lines 26-33 where the reference indicates that "the user should indicate the call to have been

unacceptable, an entry is made or updated in the memory 318; e.g. to add a significant uplift to the adjusted price received in **future** from the operator concerned, so as to make the future selection of that operator **less likely.**" Again, this is all prospective and does not reflect billing the subscriber for the service having a second characteristic rather than for the service having the first characteristic as claimed.

The Patent Office points specifically to column 6, lines 16-25 for the proposition that the billing is done based on the quality of service. However, the cited passage indicates that the selecting device can perform currency translations if the quotations provided by the service providers are in different currencies. Nothing in the passage indicates that the customer is billed based on the observed characteristic rather than the contracted characteristic.

The Patent Office then indicates that Rieken et al. teaches a flexible rate billing structure based on the specific contract the user has with the provider, citing column 3, lines 5-12. Applicant respectfully traverses this interpretation of Rieken et al. The cited passage states in full:

The process according to the invention furthermore provides for the fact that the increased charge in the network is properly indicated. The user pays his or her charges within the framework of his or her contract with the network operator. The service provider is given its percentage from the charges collected by the network operator. In this manner, the anonymity of the user is ensured.

Nothing in this passage indicates that the billing to the customer changes based on the observed characteristic. The Patent Office amalgamates the three references and announces that it renders the claimed invention obvious. This is not supported by the references or the constructions provided by the Patent Office.

During the telephonic interview of 27 January 2003, Applicant asked the Examiner what within the references constituted the claimed characteristic and asked for clarification about the parenthetical "customer" characteristic and the "vender" characteristic language used in the Office Action. The Examiner instead indicated that Gell provided teachings relating to quality of service. This statement did not identify what element within what reference is being construed as being the equivalent of what claim element. Applicant herein requests that the Patent Office identify an element within one of the references that corresponds to the characteristic; identify where in the references observations are taken to see if the customer was provided with service having the characteristic; and where the customer receiving the characteristic is billed according

to what was actually provided. The citations provided to date have not been helpful in understanding how the references are being interpreted such that the claim elements are shown.

Based on the present text of the Office Action, it is clear that the claim elements are, in fact, not shown by the references. Since none of the references teach or suggest the claim elements individually, then even combined there is still no teaching or suggestion of the claim elements and the Patent Office has not made a *prima facie* case of obviousness. Since the Patent Office has not supported its burden in constructing an obviousness rejection, the claims are allowable over the rejection of record. In short, the references, alone or in combination, do not teach providing a networking transmission service with a first characteristic (such as quality of service), observing that the networking transmission service actually has a second characteristic, and billing the customer based on the second characteristic rather than the contracted first characteristic.

Claims 2 and 3 depend from allowable claim 1 and are allowable for at least the same reasons. Claim 2 was specifically addressed in the Appeal Brief and it was therein explained how Egendorf did not teach the asserted claim elements. The Patent Office has not provided any new analysis for claim 2 nor makes any assertion that Gell or Rieken et al. cure the aforescribed deficiencies of Egendorf. For this reason, claims 2 and 3 are patentable over the rejection of record.

Claim 11 is similar to claim 1, but as explained in the Appeal Brief, is patentably distinct. The Patent Office continues to rely on the same sections of Egendorf that were addressed in the Appeal Brief (column 1, lines 4-6 and column 1, line 54-column 2, line 8). The Patent Office supplements this portion of Egendorf with Gell and Rieken et al. The portions of Gell and Rieken et al. that have been cited are identical to those cited with respect to claim 1. Thus, the analysis of these references that was provided above is equally applicable here. The differences between claim 1 and claim 11 in relevant part are not such that any of the previously provided analysis is incorrect. Thus, claim 11 defines over the rejection of record.

Claims 12-14 depend from allowable claim 11 and are allowable for at least the same reasons. Claim 13 deserves special mention because there is no new analysis provided by the Patent Office. Applicant addressed the deficiencies of Egendorf in the Appeal Brief and will not repeat those arguments. The Patent Office repeats the citations and language about Gell and Rieken et al. that were presented with respect to claim 11 with no new analysis.

Claims 4, 5, 15, and 16 were rejected under 35 U.S.C. § 103 as being unpatentable over Egendorf in view of Hilt in view of Gell, and further in view of Rieken et al. Applicant respectfully traverses. Applicant fully addressed the combination of Egendorf and Hilt in the Appeal Brief. The Patent Office's assertion that the new grounds of rejection moot the previous positions advanced by Applicant are vitiated by the Patent Office's continued reliance on the same position. The only difference in the Patent Office's position is that the Patent Office has used the same citations and language about Gell and Rieken et al. As explained in the Appeal Brief, Egendorf and Hilt do not show all the claim elements. As explained above, Gell and Rieken et al. do not show the elements missing from the independent claims. Thus, claims 4, 5, 15, and 16 are patentable for at least the reasons claims 1 and 11 are patentable.

Claims 6-10 and 17-20 were rejected under 35 U.S.C. § 103 as being unpatentable over Egendorf in view of Melen et al. in view of Gell and further in view of Rieken et al. Applicant respectfully traverses. Applicant fully addressed the combination of Egendorf and Melen et al. in the Appeal Brief. The Patent Office's assertion that the new grounds of rejection moot the previous positions advanced by Applicant are vitiated by the Patent Office's continued reliance on the same position. The only difference in the Patent Office's position is that the Patent Office has used the same citations and language about Gell and Rieken et al. As explained in the Appeal Brief, Egendorf and Melen et al. do not show all the claim elements. As explained above, Gell and Rieken et al. do not show the elements missing from the independent claims. Thus, claims 6-10 and 17-20 are patentable for at least the reasons claims 1 and 11 are patentable.

Applicant presents new claim 21 in response to the Examiner's comments during the telephonic interview. Claim 21 recites the initial step of accepting a contract from the subscriber to provide the network service and then observing that the network service provided is not that for which the customer contracted. This allows the network service provider to bill for what was provided rather than what was contracted. While the Examiner indicated that he could not, on such short notice, give an opinion as to the patentability of such a claim, the Examiner indicated that a claim similar to claim 21 would possibly help narrow the requisite field of search and provide references that might be more relevant.

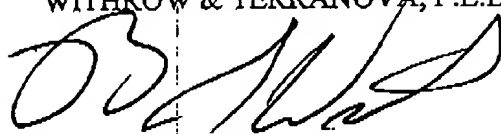
Applicant requests reconsideration of the rejections of claims 1-20 and examination of claim 21 at the Examiner's earliest convenience. The rejections of record do not properly render

the claimed invention obvious, and thus, Applicant requests claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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